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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/619,088

07/14/2003

Mark E. Steen

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01/19/2010

SMYRSKI LAW GROUP, A PROFESSIONAL CORPORATION
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EXAMINER

PRICE, NATHAN R

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

01/19/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/619,088	Applicant(s) STEEN ET AL.	
	Examiner NATHAN R. PRICE	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 77-82, 84-86, 109-114, 116-123, 125-132, 134-144 and 146-148 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 77-82, 84-86, 109-114, 116-123, 125-132, 134-144 and 146-148 is/are rejected.
- 7) ☒ Claim(s) 83, 115, 124, 133 and 145 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 23, 2009 has been entered.

Response to Amendment

2. This office action is responsive to the amendment filed on October 23, 2009. As directed by the amendment: claims 77, 109, 119, 128, and 137 have been amended, claims 1-76 and 87-108 have been cancelled, and no new claims have been added. Thus, claims 77-86 and 109-148 are presently pending in this application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 77, 79, 109, and 111 are rejected under 35 U.S.C. 102(b) as being anticipated by Helfgott et al. (US 4324243).

5. Regarding claims 77, 79, 109, and 111, Helfgott et al. discloses a method for aspirating fluid from an ocular region comprising aspirating the ocular region (abstract)

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by applying a series of modulated differential pressure pulses to the ocular region via a tubing deformation fluid control device (clamping assembly 10, fig. 4) configured to selectively deform and substantially close aspiration tubing 7 (fig. 4) to provide aspirating fluid from the ocular region (col. 5, ln. 57-59; col. 6, ln. 38-41 and ln. 44-64; col. 7, ln. 7-13); wherein selectively deforming and substantially closing aspiration tubing occurs in a controlled nonrandom manner such that fluid is aspirated according to an alterable and controllable nonrandom timing scheme (col. 5, ln. 57-59 describes the nonrandom nature of the timing involved); said negative pressure differential pulses are interspersed by brief de minimis pressure differential pulse periods (col. 7, ln. 7-13; periods between pulses).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 78, 85, 86, 110, 117, and 118 are rejected under 35 U.S.C 103(a) as being unpatentable over Helfgott et al.

8. Regarding claims 78, 85, 86, 110, and 117, Helfgott et al. discloses the method as claimed except for the specific modulation pulse duration (100 milliseconds, 8 milliseconds, and 25, milliseconds). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the duration values as claimed by Applicant since the values as claimed lack criticality for the specific pulse times and

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duration and since Helfgott et al. discloses the duration and pulse amounts can be varied (col. 5, 57-59); additionally, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

9. Claims 80-82, 84, 112-114, 116, and 119-123, 125-132, and 134-148 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helfgott et al. in view of Wright et al. (US 4702733).

10. Regarding claims 80-82, 84, 112-114, 116, 119, 121-125, 128, 130-134, 137-139, 141-144, and 146, Helfgott et al. discloses the method as claimed (see par. 5 above), including simultaneous and corresponding timing between aspiration pulses and oscillating blade pulses (see col. 5, ln. 57-59; col. 6, ln. 38-41 and ln. 44-64; col. 7, ln. 7-13), except for negative pressure differential pulses are delivered using a phacoemulsification handpiece; delivering modulated ultrasonic energy to the ocular region simultaneous with said aspirating tending to induce transient cavitation in the ocular region; timing of modulated ultrasonic energy delivery corresponds to timing of the series of modulated pressure differential pulses. However, Wright et al. teaches use of ultrasonic needle inserted into a lens so ultrasonic energy can affect the disintegration or emulsification of the lens as an alternative to use of an oscillating blade to cut or chop a diseased lens (col. 1, ln. 28-36) in combination with pinch-valve controlled irrigation/aspiration (abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize ultrasonic energy in

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conjunction with the aspiration procedures of Helfgott et al. in order to achieve disintegration or emulsification of the target tissue.

11. Regarding claims 120, 126, 127, 129, 135, 136, 140, 147, and 148, Helfgott et al. in view of Wright et al. discloses method as claimed except for the specific modulation pulse duration (100 milliseconds, 8 milliseconds, and 25, milliseconds). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the duration values as claimed by Applicant since the values as claimed lack criticality for the specific pulse times and duration and since Helfgott et al. discloses the duration and pulse amounts can be varied (col. 5, 57-59); additionally, it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Allowable Subject Matter

12. Claims 83, 115, 124, 133, and 145 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN R. PRICE whose telephone number is

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(571)270-5421. The examiner can normally be reached on Monday-Thursday, 9:00 a.m. - 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. R. P./
Examiner, Art Unit 3763

/Nicholas D Lucchesi/
Supervisory Patent Examiner, Art
Unit 3763